

REMARKS

Claim rejections under 35 USC 102

Claims 1-3, 5-13, and 16-20 have been rejected under 35 USC 102(e) as being anticipated by Okada (2002/0018237). Claims 1, 5, and 18 are independent claims, from which the remaining claims ultimately depend. Applicant submits that claims 1, 5, and 18 are patentable over Okada, such that all the pending claims are patentable over Okada.

Applicant discusses claim 1 as representative of all the independent claims 1, 5, and 18, insofar as patentability over Okada is concerned. Applicant focuses on this limitation of claim 1: “notifying each identified Internet enabled device of said specific location for said saved facsimile so that the identified Internet enabled device can later retrieve said saved facsimile from said specific location.” It is noted that the “saved facsimile” is one that has been received “as received at a specified phone number of each intended recipient of said facsimile.” It is also noted that the Internet enabled device that is notified of this location is the same Internet enabled device that can later retrieve the saved facsimile. Thus, the claimed invention is concerned with notifying each Internet enabled device of the specific location of the saved facsimile that has been received at a specified phone number of each intended recipient of the facsimile, where each such Internet enabled device can then later retrieve the facsimile. Most generally, the claimed invention relates to notification in relation to a *received* facsimile, not in relation to whether a facsimile has been properly *transmitted*. Applicant submits that all of these limitations, in relation to a saved facsimile that has been earlier *received* as opposed to having been earlier *transmitted*, is not disclose or taught by Okada.

Applicant notes that anticipation under 35 USC 102 requires that every limitation of a claim must *identically* appear in a single prior art reference for it to anticipate the claim. (In re Bond, 15 USPQ2d 1566 (Fed. Cir. 1990)) That is, the standard for anticipation under 35 USC 102 is that “[t]here must be *no difference* between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.” (Scripps Clinic & Research Found. v. Genentech, Inc., 18 USPQ2d 1001, 1010 (Fed. Cir. 1991)) For anticipation under 35 USC 102, there must be “the disclosure in a single prior art reference of

each element of the claim under consideration,” (W.L. Gore & Assocs. v. Garlock, Inc. 220 USPQ 303, 313 (Fed. Cir. 1983) “*arranged as in the claim.*” (Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co. 221 USPQ 481, 485 (Fed. Cir. 1984))

In the present case, Applicant submits that Okada does not disclose the elements of the claimed invention “*arranged as in the claim.*” Applicant respectfully submits that the Examiner has attempted to piece together some parts of Okada that relate to facsimile transmission to other parts of Okada that relate to facsimile reception. However, such a construction of Okada does not *identically* disclose the claimed invention’s elements *arranged as in the claim.* As such, there is not *no difference* between the claimed invention and the reference disclosure.

Paragraphs [0019], [0021], and [0024] of Okada

The Examiner has particularly relied upon paragraphs [0019], [0021], [0024], and [0071] in relation to the limitation of the claimed invention as to notifying each Internet enabled device of the specific location of the saved facsimile that has been received as sent to a specified phone number of each intended recipient of the facsimile. With respect to paragraphs [0019], [0021], [0024], at best all of these paragraphs relate to a *sender* of a fax, who is *transmitting* a fax, and wants to receive the results of whether such facsimile transmission was successful, as opposed to a *receiver* of a fax, who is *receiving a fax*, and wants to acquire the facsimile that has been sent to him or her, as in the claimed invention. Therefore, paragraphs [0019], [0021], and [0024] are irrelevant to the claimed invention. This is now discussed in more detail.

Paragraph [0019] of Okada does not particularly disclose “notifying each identified Internet enabled device of said specific location for said saved facsimile,” as to which the claimed invention is limited, where the saved facsimile in question is one that has been sent to the specified phone number of each intended recipient. Rather, paragraph [0019] states that there is a “function for acquiring an e-mail address of a *notification* destination node associated with facsimile data whose *process result has been detected.*” At best, paragraph [0019] is inapposite to the claimed invention, not saying anything as to notification of the location at which a saved facsimile has been saved. At worst, and more likely, paragraph [0019] appears to disclose that

the destination node is that which receives a *process result*. Such a process result makes sense in the realm of facsimile transmission – i.e., I have sent a fax and want to know the *result* of the transmission *process*. In any case, paragraph [0019] does not say anything about notifying an Internet enabled device of the specific location at which a *received* facsimile has been saved. There, paragraph [0019] is irrelevant to the claimed invention.

Paragraph [0021] of Okada is similarly specifically directed to facsimile transmission, not facsimile reception as in the claimed invention. Thus, paragraph [0021] states that “in the case where there are a plurality of requesters who request *facsimile transmission . . . process results* of individual data can individually be notified to notification e-mail addresses . . . so that a process requesting side can obtain only the result of the process it has requested.” There is nothing in paragraph [0021] about notifying an Internet enabled device of the location at which a received facsimile has been saved, in contradistinction to the claimed invention. Furthermore, paragraph [0021] elucidates what the “process result” of paragraph [0019] is about – the result of a facsimile transmission process. There, paragraph [0019] is irrelevant to the claimed invention.

Likewise, paragraph [0024] of Okada is specifically directed to facsimile transmission, not facsimile reception as in the claimed invention. Paragraph [0024] states that “the type of result information which can ensure notification is identifiable from the received facsimile data . . . so that the result can be notified *only when it matches with the result of the transmission process*,” so that a “process requesting side can dynamically designate the type of result information which it wants.” The received facsimile data here is that which is related to facsimile transmission – a requesting node sends facsimile data, which is received by the NETFAX (or whatever else is performing the faxing), and the NETFAX can look at this received facsimile data to give back to the requesting node the type of notification that it wants. At best, paragraph [0024] says nothing about notifying an Internet enabled device of the specific location at which a received facsimile has been saved, and at worst is particularly and only directed to the facsimile transmission process. There, paragraph [0019] is irrelevant to the claimed invention.

Applicant underscores the important of properly interpreting the claimed invention in relation to paragraphs [0019], [0021], and [0024] that have been discussed in detail above. The

crux of the matter is that the claimed invention is limited to notifying each identified Internet enabled device of the specific location for a saved facsimile that has been received – where this facsimile was received at a specified phone number of each intended recipient. That is, the claimed invention is limited to notifying identified Internet enabled devices of *recipients* of a fax. By comparison, paragraphs [0019], [0021], and [0024] have nothing to do with notification of recipients of a received facsimile, but rather have everything to do with notification of transmitters of a transmitted facsimile. That is, these paragraphs of Okada disclose notifying identified Internet enabled devices of *transmitters or senders* of a fax. As such, Okada does not disclose any aspect of the claimed invention in paragraphs [0019], [0021], and [0024].

Paragraph [0071] of Okada

Finally, as to paragraph [0071], Applicant notes that this paragraph is part of the embodiment disclosed in Okada as the “First Embodiment” described in paragraphs [0057] through [0071]. Indeed, this “First Embodiment” is the only embodiment in Okada that relates to receipt of a fax, as opposed to fax transmission. By comparison, the other portions of Okada do not pertain to notifying an Internet enabled device that a facsimile has been received and stored at a specific location for later retrieval by the Internet enabled device. As has been discussed above, the other paragraphs that the Examiner has relied upon (paragraphs [0019], [0021], and [0024]) at best are inapposite to facsimile reception, and at worst are explicitly directed to facsimile transmission. In these other paragraphs, Okada does not particularly disclose notifying an Internet enabled device of the location at which a received fax has been saved, in contradistinction to the claimed invention. However, paragraph [0071] does not cure teach all the limitations of notifying each identified Internet enabled device of said specific location for said saved facsimile so that the identified Internet enabled device can later retrieve said saved facsimile from said specification location. This is now discussed in more detail.

Therefore, with respect to this only embodiment of Okada that discusses facsimile reception, Okada notes that “[a] description will be given of the network structure shown in FIG. 24.” (Para. [0057]) In FIG. 24, there are relevantly a NETFAX 212, a PC 211, and a

printing machine 210. Now, in Okada's first embodiment, "NETFAX transfers the result of a reception of facsimile data, received from the PSTN, to a reception node on the LAN by e-mail." (Para. [0066]) More specifically, "[i]n the NETFAX [of FIG. 1, the facsimile section 6 receives facsimile data from the PSTN . . . and temporarily stores the facsimile data in the facsimile data storage section 5]" (Para. [0068]) Then, "[w]hen one page or whole pages of facsimile data are saved . . . printing of image data is initiated" and "the facsimile reception process is terminated." (Para. [0069]) Thereafter, the "result of the facsimile reception process is detected . . . a notification based on the process result . . . is determined" and "the notification message is [sent] by e-mail to the e-mail address of the reception node." (Para. [0070])

Therefore, what is occurring in Okada's first embodiment is that the NETFAX receives a facsimile, saves it in its data storage section 5, prints the facsimile on the printing machine 210, and once this entire process has been completed, emails the reception node – e.g., the PC 211 – that the facsimile has been received and printed on the printing machine 210. As such, a user at the PC 211 can "know when facsimile data has arrived and obtain it immediately upon arrival . . . to overcome such a problem that transmitted facsimile data does not reach the transmission destination for a long time." (Para. [0071])

In this way, however, Okada's first embodiment is different than that which is claimed in the claimed invention. In the claimed invention, an "Internet enabled device" receives a notification message, such that *this same* "Internet enabled device" can later retrieve the facsimile from the specific location indicated in the notification message. But this is not what Okada does in its first embodiment. Rather, Okada prints a saved facsimile on a printing machine 210 – thus concluding what Okada calls the "facsimile reception process" – and then notifies the PC 211 with a notification message by email that this process has been finished. Nowhere in this first embodiment of Okada can this PC 211 "later retrieve the saved facsimile at the specific location." Of course, *the user* of the PC 211 can and likely will walk over to the printing machine 210 to pick up his or her fax, but the user is not the reception node, the PC 211 is. The PC 211 is never,

in other words, able to later retrieve the saved facsimile from the specific location indicated in the notification message, unlike the claimed invention.

It is noted that, in addition to the PC 211, the printing machine 210 of Okada also cannot be considered as performing the same functionality as the Internet enabled device of the claimed invention. In the claimed invention, the Internet enabled device receives a notification message so that it can later retrieve a saved facsimile from the specific location indicated in the notification message. However, Okada first prints the facsimile on the printing machine 210, and then sends a notification to the Internet enabled device. The printing machine 210, even if it were construed to be the Internet enabled device of the claimed invention, does not later retrieve the saved facsimile from the specific location indicated in the notification message, since the printing machine 210 *already has received and has printed* the saved facsimile. For all of these reasons, therefore, Okada does not teach all the elements of the claimed invention “arranged as in the claim” as is required, and thus does not anticipate the claimed invention.

Applicant now discusses in more detail paragraph [0071] of Okada in particular. Paragraph [0071] is the concluding paragraph of the first embodiment that has been discussed above, in which a fax is received and printed on a printing machine, thus completing the facsimile reception process, and then a reception node is notified that the facsimile reception process has been concluded, so that, for instance, the user at the reception node can go to the printing machine to pick up his or her fax. Understanding what paragraph [0071] means is thus useful in understanding why Okada does not anticipate the claimed invention.

Now, paragraph [0071] recites the following:

According to this embodiment, since the result of the facsimile reception process is notified to the reception node by e-mail, it is possible to permit the reception node to know when facsimile data has arrived and obtain it immediately upon arrival by facsimile, and to overcome such a problem that transmitted facsimile data does not reach the transmission destination for a long time.

The English of this paragraph is, quite frankly, a bit tortured, and therefore some interpretation of Okada has to be made in order to understand how one of ordinary skill within the art would

consider what Okada discloses. (Applicant notes in this regard that Okada appears to have been translated from Japanese, insofar as it is a divisional patent application of another divisional patent application that was a US national stage filing of an international publication originally filed in Japanese – see field (62) of the first page of Okada, for instance.) For example, Okada discusses “the result of the facsimile reception process is notified to the reception node by e-mail,” but this is not proper usage of the term “notified.” You say “John is notified of an event,” for instance, not “the event is notified to John.” It appears in this first instance that Okada means to say that “the result of the facsimile reception process is *conveyed* to the reception node by e-mail,” instead of being “notified” to the reception node, which does not make much sense.

It is also important to understand what this “facsimile reception process” of paragraph [0071] of Okada entails. As has been described above, the “facsimile reception process” entails receiving a fax and printing it on a printing machine. That is, paragraph [0069] of Okada notes that “[t]hrough the processes from the reception of facsimile data to printing thereof, the facsimile reception process is terminated,” which seemingly suggests that once the facsimile data has been received and printed, the resulting facsimile reception process is finished. Therefore, the reception node in Okada is notified by e-mail of the result of the facsimile reception process – specifically that a fax has been received and has been printed on a printing machine.

Now, paragraph [0071] of Okada says that “[a]ccording to this first embodiment, since the result of the facsimile reception process is notified to the reception node by e-mail” (that is, the reception node is notified of the result of the facsimile reception process, which concludes upon printing of the received fax), “it is possible to permit the reception node to know when facsimile data has arrived and obtain it immediately upon arrival by facsimile.” Again, we have some tortured English to deal with in this paragraph. Okada says that “it is possible to permit the reception node to know when facsimile data has arrived and obtain it immediately upon arrival by facsimile.” Of course, what Okada means is that “it is possible to permit the reception node to know when the facsimile data has arrived and *for the user* to obtain it immediately upon [*its*] arrival by facsimile.”

This is an important distinction. The reception node *itself* cannot really obtain the facsimile data upon the facsimile data having arrived by facsimile in accordance with the conclusion of the facsimile reception process of Okada's first embodiment. This is because the facsimile reception process, as described in detail in Okada in paragraphs [0066] through [0070], involves the NETFAX receiving a fax and printing it, and after the conclusion of this facsimile reception process, sending the reception node a notification by e-mail. The only way the reception node itself could "obtain [the fax] immediately" is for it to nonsensically walk over to the printing machine and pick up the hardcopy of the fax! It is clear, in other words, that in Okada's tortured English, what Okada means is that *the user* of the reception node – not the reception node itself – can immediately obtain the facsimile, by walking over to the printing machine and pick up the hardcopy of the fax.

That is, where Okada in paragraph [0071] says that "[a]ccording to this first embodiment" described in paragraphs [0066] through [0070], "since the result of the facsimile reception process is notified to the reception node by e-mail" (that is, the reception node is notified of the result of the facsimile reception process), we have to look at what this facsimile reception process entails in interpreting what Okada then means when it says that "it is possible to permit the reception node to know when facsimile data has arrived and obtain it immediately." The facsimile reception process is described in Okada as receiving and printing a fax. It does not make sense to take Okada's statement that "it is possible to permit the reception node to know when facsimile data has arrived *and obtain it immediately*" in light of what the facsimile reception process actually is, since a reception node – i.e., a computer like a PC – cannot obtain something that has been printed out on paper.

That is, no different than you have to interpret Okada's saying that "the result of the facsimile reception process is notified to the reception node by e-mail" to mean that "the reception node is notified of the result of the facsimile reception process by e-mail" – since it is the reception node being notified of the result, not the result being notified of the reception node – you likewise have to interpret Okada's saying that "it is possible to permit the reception node to .

. . obtain [the facsimile] immediately” to mean that “it is possible to permit *the user of* the reception node to obtain the facsimile immediately.” Where Okada has been translated from the Japanese, in other words, we cannot fall into the trap of making a literal but nonsensical interpretation of Okada, but rather have to look to the whole of Okada to see what it actually discloses and teaches.

In this sense, Applicant refers the Examiner to the Federal Circuit decision Paperless Accounting, Inc. v. Bay Area Rapid Transmit Sys., 804 F.2d 659, 231 USPQ 649, 653 (Fed. Cir. 1986). A prior art reference must be enabling under 35 USC 112, first paragraph. (804 F.2d at 665, 231 USPQ at 653) The description of a reference must enable a person with ordinary skill in the art to comprehend the invention as well as make it. (*Id.*) Here, we cannot take the words of paragraph [0071] of Okada at face value, since one of ordinary skill within the art would not be able to *comprehend*, nor make, the invention of Okada as the words of paragraph [0071] suggest at face value. Rather, understanding that Okada is a somewhat poor English translation of a patent application originally filed in Japanese, we have to interpret paragraph [0071] properly in the same way that one of ordinary skill within the art would to make the invention that Okada teaches in the foregoing paragraphs [0066] through [0070].

To conclude, Applicant would like to cite no less an authority than Irrah H. Donner’s seminal work, “Patent Prosecution: Law, Practice, and Procedure” (4th ed., vol. I), in which Mr. Donner notes the following:

The Examiner must provide a reasonable basis for stating that a prior art reference under Subsection 102(a), (b), (d), (e), or (g) sufficiently describes the subject matter therein to place the subject matter in the public domain. Thus, if an Examiner’s assertion that the reference adequately describes the subject matter to place it in the public domain is unreasonable or outrageous, an applicant can attack this element of anticipation to prevent the prime face case of anticipation. If the reference does not teach, no anticipation can be found.

(Ch. 7.V.B, p. 952) Here, Okada does not actually *teach* a reception node obtaining a facsimile after it has received notification that a facsimile has been received and printed. Rather, what Okada actually *teaches* is that a facsimile is received and printed, and then a reception node is

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notified of this fact. Therefore, even though paragraph [0071] of Okada says that a reception node obtains a facsimile after the facsimile has been printed, what Okada actually means – and what Okada actually teaches – is that a user of the reception node can obtain the facsimile after it has been printed and the reception node has received an email to that effect. This is especially true here, where it appears that Okada has been translated (poorly) to English from Japanese, and where to make sense of other parts of its disclosure – including the very first part of paragraph [0071], as has been discussed above – we also have to decipher what Okada means instead of what at face value it says.

Respectfully Submitted,



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